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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Robert J. Sicurelli JR.

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ALFRED M. WALKER

225 OLD COUNTRY ROAD

MELVILLE, NY 11747-2712

EXAMINER

WILSON, JOHN J.

ART UNIT

PAPER NUMBER

3732

MAIL DATE

DELIVERY MODE

01/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/990,932

Applicant(s)

SICURELLI ET AL.

Examiner

John J. Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-35, 38-40, 42, 44-46, 50, 52-61, 64, 65 and 70-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-35, 38-40, 42, 44-46, 50, 52-61, 64, 65 and 70-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33-35, 38-40, 42, 44-46, 50, 52-61, 64, 65 and 70-104 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In all of the independent claims, the new language, "tooth-force-vectoring", and "wherein said force vectoring comprises dissipation of energy by shifting of stress under excessive tooth force loads, for saving a force-overloaded tooth and further wherein said post has a flexibility approximating the flexibility of a tooth structure; and wherein said post has a modulus of elasticity approximating the modulus of elasticity of a tooth structure" is new matter not supported by the application as originally filed. It is noted that applicant argues that this language is supported by applicant's prior patent, 5518399, serial number 08/126,631, to which priority has been claimed, however, while the new rules allow for incorporation by reference to applications for which priority is claimed, these rules are only effective for applications filed after September 21, 2004. In view of this, the present application can only use disclosure in an application that it is a continuation of if the previous application is properly incorporated by reference and

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then the incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts, MPEP 201.06(C) IV. Because this application or patent have not been properly incorporated by reference, matter from this patent introduced into this application is improper new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33, 35, 38, 42, 44-46, 50, 53-61, 64, 65, 70, 71, 74-82, 84, 85, 88, 89 and 91-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Albert (5564929). Reynaud shows a prefabricated post comprising a bundle of non-metallic and non-woven fibers 5 in a resin 4. The fibers and resin of Reynaud are inherently flexible to some degree, however, Reynaud shows using carbon fibers not glass. Albert teaches the use of alternative fibers including carbon or glass, column 2, lines 59-65. It would be obvious to one of ordinary skill in the art to modify Reynaud to include the use of glass fibers as suggested by Albert in order to make use of known alternative materials in order to obtain the desired known properties of those materials. Reynaud teaches matching properties of the tooth including the modulus of

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elasticity. To use the inherently more flexible glass to better match such properties would have been obvious to one of ordinary skill in the art. The specific shape of the post used is an obvious matter of choice in shape to best match the canal. To include force vectoring and to approximately match the flexibility of a natural tooth are obvious matters of choice in the degree of matching the tooth properties to one of ordinary skill in the art. The specific type of glass fibers used is an obvious matter of choice in known materials to one of ordinary skill in the art. The specific type of resin used is an obvious matter of choice in the use of known materials to the skilled artisan. To include surface texturing or facets are well known to one of ordinary skill in the post art in order to improve the hold in the tooth canal. To call the post, a pin, is merely terminology, and therefore, is not given patentable weight. Reynaud shows compacted fibers in the drawings, however, does not state a type or degree of compacting. The limitation "loosely" is a relative term that describes a degree of compacting that can depend on comparison and/or interpretation, and as such, the degree of compactness of the fibers is an obvious matter of choice in the degree of a known parameter to one of ordinary skill in the art. Reynaud does not show twisted fibers. Albert shows twisted fibers in Figs. 4 and 8. It would be obvious to one of ordinary skill in the art to modify Reynaud to include twisting the fibers as shown by Albert in order to make use of known shapes to obtain the desired properties. The shown structure of Reynaud is inherently capable of being positioned above the coronal end of a tooth canal in use. The structure of Reynaud is inherently capable of being selectively flared depending on the intended use.

Claims 34 and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Albert (5564929) as applied to the claims above, and further in view of Kwiatkowski (4936776). The above combination does not show translucent. Kwiatkowski teaches using a translucent post. It would be obvious to one of ordinary skill in the art to modify the above combination to include a translucent post as shown by Kwiatkowski in order to preserve the normal look of a tooth.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Albert (5564929) as applied to the claims above, and further in view of Al Kasem (5326264). The above combination does not show using an opaque material. Al Kasem teaches using an opaque filler, column 18, line 19. It would be obvious to one of ordinary skill in the art to modify the above combination to include the use of an opaque material as shown by Al Kasem in order to make use of known materials for best matching the tooth.

Claims 40 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Albert (5564929) as applied to the claims above, and further in view of Weissman (5326263). The above combination does not show a end shaped to be rounded and to direct light. Weissman shows an end shaped to direct light, Fig. 6, that can be rounded, column 5, lines 1-3 and column 6, lines 1-4, and to direct light. It would be obvious to one of ordinary skill in the art to modify the

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above combination to include a shaped end as shown by Weissman in order to direct light. To shape the end by polishing is an obvious matter of choice in the process used to obtain a known structure to the skilled artisan.

Claims 72 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Albert (5564929) and Al Kasem (5326264) as applied to the claim 39 above, and further in view of Fujisawa et al (4931096). The above combination does not show the use of a radio opaque material. Fujisawa teaches the use of radio opaque material including barium sulfate, column 2, lines 10-16. It would be obvious to one of ordinary skill in the art to modify the above combination to include radio opaque material as shown by Fujisawa in order to enable the material to show up on radiograph.

Claims 83, 86 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Albert (5564929) as applied to the claims above, and further in view of Fujisawa et al (4931096). The above combination does not show the use of a radio opaque material. Fujisawa teaches the use of radio opaque material including barium sulfate, column 2, lines 10-16. It would be obvious to one of ordinary skill in the art to modify the above combination to include radio opaque material as shown by Fujisawa in order to enable the material to show up on radiograph.

Claim 104 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Albert (5564929) as applied to the claims above, and further in view of Nordin (5282747). The above combination does not show a core spacer. Nordin shows a core spacer 46. It would be obvious to one of ordinary skill in the art to modify the above combination to include a core spacer as shown by Nordin in order to better hold a crown.

Claims 33, 35, 38, 42, 44-46, 50, 53-61, 64, 65, 70, 71, 74, 77, 95 and 97-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012). Reynaud shows a post comprising a bundle of non-metallic and non-woven fibers 5 in a resin 4. The fibers and resin of Reynaud are inherently flexible to some degree, however, Reynaud shows using carbon fibers not fiberglass. Goldberg teaches the use of alternative fibers including carbon or glass, column 6, lines 13-19, for producing dental appliances. It would be obvious to one of ordinary skill in the art to modify Reynaud to include the use of glass fibers as suggested by Goldberg in order to make use of common alternative materials in order to obtain the desired known properties of those materials, the combination being further obvious because teaches the use of many different reinforcing fibers, and gives no criticality to the use of fiberglass. Reynaud teaches matching properties of the tooth including the modulus of elasticity. To use the inherently more flexible glass to better match such properties would have been obvious to one of ordinary skill in the art. To include force vectoring and to approximately match the flexibility of a natural tooth are

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obvious matters of choice in the degree of matching the tooth properties to one of ordinary skill in the art. The specific shape of the post used is an obvious matter of choice in shape to best match the canal. The specific type of glass fibers used is an obvious matter of choice in known materials to one of ordinary skill in the art. The specific type of resin used is an obvious matter of choice in the use of known materials to the skilled artisan. To include surface texturing or facets are well known to one of ordinary skill in the post art in order to improve the hold in the tooth. To call the post, a pin, is merely terminology, and therefore, is not given patentable weight. Reynaud shows compacted fibers in the drawings, however, does not state a type or degree of compacting. The limitation "loosely" is a relative term that describes a degree of compacting that can depend on comparison and/or interpretation, and as such, the degree of compactness of the fibers is an obvious matter of choice in the degree of a known parameter to one of ordinary skill in the art.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012) as applied to the claims above, and further in view of Kwiatkowski (4936776). The above combination does not show translucent. Kwiatkowski teaches using a translucent post. It would be obvious to one of ordinary skill in the art to modify the above combination to include a translucent post as shown by Kwiatkowski in order to preserve the normal look of a tooth.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012) as applied to the claims above, and further in view of Al Kasem (5326264). The above combination does not show using an opaque material. Al Kasem teaches using an opaque filler, column 18, line 19. It would be obvious to one of ordinary skill in the art to modify the above combination to include the use of an opaque material as shown by Al Kasem in order to make use of known materials for best matching the tooth.

Claims 40 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012) as applied to the claims above, and further in view of Weissman (5326263). The above combination does not show a end shaped to be rounded and to direct light. Weissman shows an end shaped to direct light, Fig. 6, that can be rounded, column 5, lines 1-3 and column 6, lines 1-4, and to direct light. It would be obvious to one of ordinary skill in the art to modify the above combination to include a shaped end as shown by Weissman in order to direct light. To shape the end by polishing is an obvious matter of choice in the process used to obtain a known structure to the skilled artisan.

Claims 72 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012) and Al Kasem (5326264) as applied to the claim 39 above, and further in view of Fujisawa et al (4931096). The above combination does not show the use of a radio opaque material.

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Fujisawa teaches the use of radio opaque material including barium sulfate, column 2, lines 10-16. It would be obvious to one of ordinary skill in the art to modify the above combination to include radio opaque material as shown by Fujisawa in order to enable the material to show up on radiograph.

Claims 75, 76, 78-82, 84, 85, 88, 89, 91, 96 and 100-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012) as applied above, and further in view of Himmel et al (GB 2214087). The above combination does not show twisted fibers. Himmel shows twisting fibers, page 3, last paragraph. It would be obvious to one of ordinary skill in the art to modify the above combination to include twisting the fibers as shown by Himmel in order to make use of known shapes to obtain the desired properties. The shown structure of Reynaud is inherently capable of being positioned above the coronal end of a tooth canal in use. The structure of Reynaud is inherently capable of being selectively flared depending on the intended use.

Claims 83, 86 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012) as applied to the claims above, and further in view of Fujisawa et al (4931096). The above combination does not show the use of a radio opaque material. Fujisawa teaches the use of radio opaque material including barium sulfate, column 2, lines 10-16. It would be obvious to one of ordinary skill in the art to modify the above combination to include radio opaque

material as shown by Fujisawa in order to enable the material to show up on radiograph.

Claim 90 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012) and Himmel et al (GB 2214087) as applied to claim 78 above, and further in view of Kwiatkowski (4936776). The above combination does not show translucent. Kwiatkowski teaches using a translucent post. It would be obvious to one of ordinary skill in the art to modify the above combination to include a translucent post as shown by Kwiatkowski in order to preserve the normal look of a tooth.

Claim 104 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) in view of Goldberg et al (4894012) and Himmel et al (GB 2214087) as applied to claim 102 above, and further in view of Nordin (5282747). The above combination does not show a core spacer. Nordin shows a core spacer 46. It would be obvious to one of ordinary skill in the art to modify the above combination to include a core spacer as shown by Nordin in order to better hold a crown.

Response to Arguments

Applicant's arguments filed October 30, 2007 have been fully considered but they are not persuasive. With respect to the new language added to the claims, see rejections above. With respect to Alpert not being prior art because the 5,518,399

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patent teaches using fiberglass with the embodiment shown in Fig. 8, reasoning the language used, "spacer 20 and post reinforcing rod 30 are preferably formed from reinforced plastics such as fiberglass polyester composites", column 5, lines 53 and 54, in describing the embodiment of Figs. 1-3, teaches that the language "reinforced plastics" includes fiberglass polyester composites, and as such, when the same terminology is used to describe the embodiment of Fig. 8, that is, that post 100 and rod 130 are made from "reinforced plastics", column 7, lines 35-37, this teaches using fiberglass polyester composites in this embodiment as well. The examiner disagrees with this argument because for a teaching to be enabling, it clearly teach the invention as claimed. Features describing one embodiment do not clearly teach that the same features apply to all embodiments, as such, the '399 patent does not enable the use of fiberglass with the embodiment of Fig. 8. The terminology prefabricated is directed to a method of use and a time of use. The above rejections are based on an article, and as such, the above combinations properly show the materials were known and obvious to one of ordinary skill in the art. That Albert and Goldberg may be used in a different method does not obviate the combination as applied against the claimed article. The time at which and known and obvious structure is made does not obviate over the structure.

The Declaration under 37 CFR 1.132 filed October 30, 2007 is insufficient to overcome the rejection of the claims based upon the applied art as set forth because

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the declaration merely states opinions of one of the inventors with respect to the prior art and the rejections made and fails to provide evidence to support those opinions.

The opinions mirror applicant's remarks, and as such, are responded to above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722). The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez, can be reached at 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***/John J Wilson/
Primary Examiner
Art Unit 3732***

jw
January 2, 2008